REMARKS

Claims 1-16 and 18-55 are pending and at issue in this application. This paper is being presented in response to the final Office Action dated September 28, 2006.

Applicants respectfully traverse the rejection of claims 1-6, 8-16, 18-21, 23-44, and 46-55 under 35 U.S.C. §103(a) as obvious over Spriggs et al., U.S. Patent No. 6,421,571 ("Spriggs") in view of Forney et al., U.S. Pat. Pub. No. 2002/0067370 (the "Forney Publication"), and respectfully traverse the rejection of claims 7, 22 and 45 under 35 U.S.C. §103(a) as obvious over Spriggs in view of Hays et al., U.S. Patent No. 5,855,791 ("Hays"). Reconsideration and withdrawal of the rejections of claims 1-16 and 18-55 are respectfully requested in view of the following remarks.

I.   The Prior Art Rejections Are Improper as Being Based on a Publication That is Not Available as Prior Art

The examiner has failed to establish a *prima facie* case of obviousness in this case as the examiner has failed to establish that the Forney Publication, or any of the cited portions thereof, is actually prior art under any subsection of 35 U.S.C. §102, including §102(e). Moreover, applicants submit that the Forney Publication, in the manner used by the examiner, is not prior art to the present application. For this reason, the prior art rejections are improper and should be withdrawn.[1]

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[1] While claims 7, 22 and 45 are not specifically rejected over the Forney Publication, applicants submit that the examiner's rejection of claims 7, 22 and 45 is deficient on its face for not including the Forney Publication. In particular, each of these claims depends from one of independent claims 1, 16 and 37. The examiner has admitted that each of independent claims 1, 16 and 37 recites an element not disclosed or suggested by Spriggs, i.e., that the outside service provider implements the service application. (See, e.g., Final Office Action dated September 28, 2006, page 3, paragraph 6). Moreover, the examiner has not alleged that Hays provides any disclosure or suggestion of this missing element, nor does it. As a result, the rejection of claims 7, 22, and 45 is deficient because it fails include prior art that provides any disclosure or suggestion of an element the examiner admits is missing from Spriggs et al. Applicants submit that, to the extent the examiner intended to continue with this combination, the examiner must have meant to include the Forney Publication in the manner used to reject independent claims 1, 16 and 37. However, for the reasons provided below, the Forney Publication, in the manner used by the examiner, is not available as prior art. As a result, this modified rejection of claims 7, 22 and 45 is also deficient for the reasons provided below with respect to independent claims 1, 16 and 37.

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Applicants note the that present application claims priority as a Continuation Application to U.S. Patent Application Serial No. 09/953,811, (hereinafter the "'811 parent application") which was filed on September 17, 2001. Because the present application is fully supported by the '811 parent application, the present application is entitled to a filing date of at least as early as September 17, 2001. U.S. Patent Application Serial Number 09/955,473 (hereinafter the "Forney Regular Application"), which published as the Forney Publication, was filed on September 17, 2001, which is the same day as the filing date of the present application. As a result, the specific disclosure of the Forney Publication is only prior art under 35 U.S.C. §102(e) to the extent that this disclosure is fully supported by disclosure present within an application filed prior to September 17, 2001 (the filing date of the present application) and to which the Forney Regular Application claims priority. While the Forney Regular Application claims priority to a provisional application (U.S. Provisional Application Serial. No. 60/232,733, hereinafter referred to as the "Forney Provisional Application"), the examiner has not even alleged, much less shown, that in every instance, the disclosure of the Forney Publication relied upon on by the examiner is fully supported by the Forney Provisional Application. As a result, the examiner has failed to establish that the Forney Publication is actually prior art to any of the claims of the present application, and therefore has failed establish of a *prima facie* of case of obviousness.

Moreover, applicants submit that the examiner *cannot* establish that each element and section of the Forney Publication relied upon by the examiner in making the prior art rejections is supported by the disclosure of the Forney Provisional Application. Importantly, the Forney Provisional Application is significantly different than the Forney Regular Application, and appears to be simply one or more Power Point presentations and one or more marketing documents concatenated together. While the examiner appears to rely on paragraph [0347] of the Forney Publication for the disclosure of "using an outside service provider for implementing a service application for collecting data from a plurality of sources within a plant," this paragraph does not appear to be literally supported by or present within the Forney Provisional Application. Moreover, the examiner has not shown or even alleged that the Forney Provisional Application supports the disclosure of the Forney

Publication relied upon by the examiner in making the asserted combination. Because the examiner has, in rejecting each of the pending claims, relied on portions of the Forney Publication that are not believed to be prior art with respect to the present application, the prior art rejections are improper. For this reason, the rejections of each of the pending claims should be withdrawn.[2]

II.   The Pending Claims Recite Patentable Subject Matter Over the Cited Art

Each of the pending claims stands rejected under 35 U.S.C. §103(a) as obvious over Spriggs in view of the Forney Publication or Hays. Reconsideration and withdrawal of these rejections are respectfully requested, as the applicants submit that the examiner has not established a *prima case* of obviousness. The applicants accordingly traverse the art-based rejections on at least the following grounds.

As set forth in MPEP §2142, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all of the claim limitations.

Each of independent claims 1, 16, 27 and 37 requires, *inter alia*, that data is collected, stored and/or made accessible or available to a plurality of applications, including an application implemented by an outside service provider remotely from the process plant, and that data from the outside service provider application is provided back to the process plant for use by other applications. By this amendment, the claims have been amended to clarify that the outside service provider performs the service application remotely from the process plant to more clearly distinguish third party applications run within the process plant from third party applications run remotely from the process plant. In any event, the claimed methods and systems use an application implemented by a third party service provider remotely from the

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[2] To the extent that the examiner believes that sections of the Forney Publication which are supported by the Forney Provisional Application render obvious any of the pending claims, the examiner must issue a new, non-final office action limiting the analysis to these sections of the Forney Publication, and illustrating how these sections are fully supported by the Forney Provisional Application.

process plant, but incorporate this application into the data collection and distribution system as if this application were an internal application implemented on the assets or computers of the process control plant so that data made available to the internal applications is also made available to the remotely implemented third party application, and so that data produced by the remotely implemented third party application is also made available to internal applications within the plant via a common data storage and distribution system. Thus, the claimed methods and systems collect data from a plurality of data sources and provide the collected data to a number of applications, including the remote third party service provider application and, in addition, collect data generated by the remote service provider application and store that data so as to make that additional data available to other applications within the process plant, such as to process control applications and maintenance applications implemented within the process plant.

None of Spriggs, the Forney Publication or Hays discloses or suggests a system that integrates a third party application implemented remotely by a third party service provider in a manner in which data from the process plant is first collected by an internal system and is made available to a set of internal applications in addition to being provided externally to the third party service provider application and which further collects data from the third party service provider application and provides this data back to other applications within the plant, such as to process control applications and maintenance applications used within the process plant.

In particular, while Spriggs discloses a data collection system that provides sensor data to "third party" software (see element 60, Fig. 3), each of these "third party" software applications is clearly implemented within the process plant environment itself, and receives data directly from the sensors 70 of the process plant. As admitted by the examiner, Spriggs fails to disclose any manner of incorporating a third party application that is implemented remotely from the process plant into the data collection and viewing system described therein. (See, Final Office Action dated September 28, 2006, page 3, paragraph 6.) Moreover, Spriggs specifically indicates that it only incorporates third party machines and process control applications *within* the plant. Thus, for example, the Spriggs system specifically "gather[s] information from multiple information sources *within* the plant control and automation systems

and synchronously integrat[es] the information onto a single unified display environment." (Emphasis added, Spriggs, column 2, lines 34-38). Spriggs simply provides no disclosure of or motivation for implementing third party software or any other element thereof remotely from the process plant.

To this point, the applicants specifically disagree with the examiner's reading of col. 2, lines 12-39 of Spriggs as disclosing the concept of collecting data from a plurality of data sources in a process plant wherein the plurality of data sources includes a service application that is implemented by a service provider to the process plant. At no point does this or any other section of Spriggs disclose that a third party implements applications for the process plant of Spriggs. At best, this section discloses that third party applications or software could be used within the plant and that the plant can communicate with these third party applications using known types of interfaces. This is not the same as disclosing that a third party actually implements the software within the plant. In fact, using an application or software created by a third party within a process plant is much different than having a third party actually implement their own software, either within or remotely from the plant.

Still further, applicants disagree with the Examiner's contention that col. 6, line 49 to col. 7, line 25 of Spriggs discloses making stored data collected within the process plant accessible to a third party service application. This disclosure is specifically related to the utilities modules 200 and to the data explorer modules 300 of Fig. 3. While the utilities module 200 includes software modules, the software modules are used to increase communication abilities and functionality within the system and, specifically, are used to communicate with third party applications run *within* the plant as shown in the Fig. 3. Likewise, the data explorer modules are interfaces that allow the system to communicate with third party control and automation systems, which control and automation systems must be located within the plant, via known interfaces. Thus, in no manner does this section of Spriggs disclose the concept of making stored data accessible to an external service application implemented by a third party, as is recited by each of the independent claims.

Still further, as indicated above, the examiner has failed to identify any other specific prior art that teaches providing data in any manner from a database to a remotely implemented third party application and back, much less from a database to

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multiple applications, wherein one of these applications is a remotely implemented third party application, and then back from the remotely implemented third party application to the database for use by the other applications. Hays simply is not concerned with third party applications and the cited portions of the Forney Publication are not believed to be prior art in this case, much less to disclose this data communication and storage structure.

Moreover, and contrary to the examiner's apparent contention, modifying Spriggs so that the "third party software" of Fig. 3 is implemented remotely from the process plant would still not produce the claimed invention, regardless of whether or not such a modification would have been obvious to one of ordinary skill in the art.[3] In particular, as explained above, the claimed systems and methods provide a collected set of data to one or more internal applications, such as to process control applications, maintenance applications, etc., as well as to the remotely implemented third party application and, in addition, collect and provide data generated by the remotely implemented third party application to a database to be made available to the other internal applications. In this manner, no special data links etc. need to be set up to support or provide data to the remotely implemented third party application and the remotely implemented third party application has access to the same data as provided to other internal applications. Likewise, all of these applications can get the data, including the data generated by the remotely implemented third party application, from the same source.

The "third party software" of Fig. 3 of Spriggs, on the other hand, obtains data directly from the sensors 70 within the plant and thus does not have access to the data that is sent to or that is provided to other applications within the plant. Moreover, the data that is provided to the "third party software" of Spriggs is not stored in the database to which the other applications within the plant have access (i.e., the database 82). This configuration is specifically shown in Fig. 3 of Spriggs, in which the transducers/sensors 70 provide collected data directly to the "third party machine and process controllers applicable data sources, software and hardware devices" within the plant, without this data being stored in the database 82 or being provided to other applications within the plant. Thus, Spriggs fails to disclose a system in which

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[3] A point to which the applicants do not concede.

the third party applications (whether operated on site or remotely) have access to data that is also provide to or stored within a common database accessible by other applications within the plant, while at the same time storing the data generated by the "third party software" in the database to be used by other applications within the plant. As a result, implementing the "third party software" of Spriggs remotely, as suggested by the examiner, would still not produce the claimed systems and methods.

Likewise, neither the Forney Publication nor Hays discloses or suggests a system in which this two-way data communication occurs, i.e., in which data from data sources is provided to database and from there to both internal and outside service provider applications, and in which the data from the outside service provider application and possibly the internal applications is provided to the database to be distributed to the other applications. In fact, as indicated in prior responses, neither the Forney Publication nor Hays actually discloses using outside service providers to remotely implement service applications used to support process plants, but at best merely disclose web-service communication systems for use in illustrating data to users.

For these reasons, it is respectfully submitted that a *prima facie* case of obviousness has not been and cannot be established based on any combination of Spriggs, the Forney Publication and Hays. It follows therefore that claims 1-16 and 18-55 recite patentable subject matter over any combination of these documents.

III.   Conclusion

For the foregoing reasons, the applicants respectfully request reconsideration and allowance of claims 1-16 and 18-55. If there are matters that can be discussed by telephone to further the prosecution of this application, the applicants respectfully request that the examiner call their attorney at the number listed below.

Respectfully submitted,

By: _____

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